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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DORSEY & WHITNEY LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
SUITE 3400  
1420 FIFTH AVENUE  
SEATTLE, WA 98101

EXAMINER
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SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/923,663

Applicant(s)

NEW ET AL.

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-30 are presented for examination. Claims 31-34 have been cancelled.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Independent claim 27 and their dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The various steps conversion, substituting, recording and searching are software constructs (software per se) performing various functionalities. These functionalities do not manipulate any hardware or tangible entity. Therefore, these software constructs are non statutory entities as detailed in MPEP 2106.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1, 2, 4-9, 11, 13-17, 19, 21-25, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Patel et al (6,918,113) (hereinafter Patel).

6. As per claim 1, Patel discloses a method for providing access to computer resources on a computer system, comprising:

generating at a server (2205, fig 22, Licensing server) a token containing encrypted user information including credit, authorization, and authentication (col 8, line 57 to col 10, line 67);

transmitting the token to the computer system (license server provides token Access token to the client, 2205, fig 22, col 26, lines 62-65);

transmitting a computer resource to the computer system, the computer resource being encrypted (2210, fig 22, col 26 line 62 to col 27, line 14);

initiating a request to open the computer resource stored on the computer system (2210, fig 22, col 26 line 62 to col 27, line 14);

initiating execution of a remote application manager component on the computer system (2210, fig 22, col 26 line 62 to col 27 line 14; col 28, lines 46-67);

under control of the remote application manager component (2210, fig 22, col 26 line 62 to col 27, line 14),

for both broken-connection (locally installed application, CD-ROM, trial application, downloadable applications etc., col 1, lines 25-58) and continuous connection environments (connection between 2210 and 2212 of fig 22; col 30, lines 50-55) decrypting at the computer system the token and authenticating a user of the computer system using authentication information stored in the token (2210, fig 22, col 26 line 62 to col 27 line 14; col 28, lines 46-67);

verifying whether the user is authorized to use the requested computer resource using authorization information stored in the token (2210, fig 22, col 26 line 62 to col 27 line 14; col 28, lines 46-67; col 8, line 57 to col 9, line 34);

verifying whether the user has sufficient credit contained in the token to use the requested computer resource using credit information stored in the token (col 8, line 57 to col 9, line 34);

when the user is authenticated, authorized, and has sufficient credit, decrypting and opening the requested computer resource (2210, fig 22, col 26 line 62 to col 27 line 14; col 28, lines 46-67; col 8, line 57 to col 9, line 34);

monitoring the usage of the opened computer resource to determine whether the user has sufficient credit (license server does the monitoring, col 10, lines 31-46) to continue using the computer resource (2210, fig 22, col 26 line 62 to col 27 line 14; col 28, lines 46-67; col 8, line 57 to col 10, line 26); and

providing a notification (renew the access token, col 10, lines 31-46) when the monitored usage of the opened computer resource has exceeded the credit (2210, fig 22, col 26 line 62 to col 27 line 14; col 28, lines 46-67; col 8, line 57 to col 10, line 67).

7. As per claim 2, Patel discloses generating a token comprises collecting authentication, authorization, and credit information from the user and storing the information in respective fields in a binary file, and thereafter

encrypting the binary file to generate the token (col 26 line 62 to col 27 line 14; col 28, lines 46-67; col 8, line 57 to col 10, line 67).

8. As per claim 4, Patel discloses initiating a request to open a computer resource comprises clicking on an application icon (col 2, lines 53-57).

9. As per claim 5, Patel discloses initiating execution of a remote application manager component occurs in response to initiating a request to open a computer resource (col 2, lines 39-65).

10. As per claim 6, Patel discloses the token and the computer resource have been encrypted using the public key encryption methodology (col 9, lines 9-28).

11. As per claim 7, Patel discloses wherein the computer resource comprises an application module (2211, fig 22).

12. As per claim 8, Patel discloses the application module comprises an entire executable application program that is stored in encrypted form on the computer system (col 26 line 62 to col 27 line 14; col 28, lines 46-67;

col 8, line 57 to col 10, line 67).

13. As per claim 9, Patel discloses monitoring the usage of the opened computer resource comprises monitoring how long the user has been using the computer resource (col 8, line 57 to col 10, line 67).

14. As per claim 11, the claim is rejected for the same reasons as claim 1, above.

15. As per claim 13, the claim is rejected for the same reasons as claim 4, above.

16. As per claim 14, the claim is rejected for the same reasons as claim 6, above.

17. As per claim 15, the claim is rejected for the same reasons as claim 7, above.

18. As per claim 16, the claim is rejected for the same reasons as claim 8, above.



19. As per claim 17, the claim is rejected for the same reasons as claim 9, above.

20. As per claim 19, the claim is rejected for the same reasons as claim 1, above.

21. As per claim 21, the claim is rejected for the same reasons as claim 4, above.

22. As per claim 22, the claim is rejected for the same reasons as claim 6, above.

23. As per claim 23, the claim is rejected for the same reasons as claim 7, above.

24. As per claim 24, the claim is rejected for the same reasons as claim 8, above.

25. As per claim 25, the claim is rejected for the same reasons as claim 9, above.

26. As per claim 27, the claim is rejected for the same reasons as claim 1, above.

27. As per claim 28, Patel discloses the request to initiate execution of a selected one of the computer resources comprises a request to initiate execution of a computer resource component not found on the client system, and the remote application manager component is further operable to contact a server system responsive to this request to initiate transfer of the selected computer resource component to the client system along with an updated token component including updated authorization information for the computer resource component (fig 22, col 26 line 62 to col 27 line 14; col 28, lines 46-67; col 8, line 57 to col 10, line 67).

28. As per claim 29, Patel discloses the remote application manager is further operable to contact a server system when the credit contained in the token component is insufficient to initially open or to continue executing the selected computer resource component to initiate transfer of an updated token component including updated credit information to the client system (renewed token, fig 22, col 26 line 62 to col 27 line 14; col 28, lines 46-67; col 8, line 57 to col 10, line 67).

***Claim Rejections - 35 USC § 103***

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 3, 10, 12, 18, 20, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. (6,918,113) (hereinafter Patel) in view of Safadi et al. (6,810,525) (hereinafter Safadi).

31. As per claim 3, Patel does not specifically disclose the token is stored on a smart card that the remote application module component accesses to retrieve and decrypt the token. However, it is commonly known in the art. For example, Safadi discloses the token is stored on a smart card that the remote application module component accesses to retrieve and decrypt the token (subscriber terminal, col 2, lines 7-10). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Safadi and Patel. The motivation would have been accessing pay-per-use services from multiple devices without requiring a new infrastructure.

32. As per claim 10, Patel does not specifically disclose providing a notification when the monitored usage of the opened computer resource has exceeded the credit comprises displaying a visual message to the user instructing the user to save his work and indicating his credit has been depleted. However, Safadi discloses providing a notification when the monitored usage of the opened computer resource has exceeded the credit comprises displaying a visual message to the user instructing the user to save his work and indicating his credit has been depleted (absolute visibility, col 6, lines 60-65). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Safadi and Patel. The motivation would have been accessing real-time renewing pay-per-use services.

33. As per claim 12, the claim is rejected for the same reasons as claim 3, above.

34. As per claim 18, the claim is rejected for the same reasons as claim 10, above.

35. As per claim 20, the claim is rejected for the same reasons as claim 3, above.

36. As per claim 26, the claim is rejected for the same reasons as claim 10, above.

37. As per claim 30, Patel fails to disclose the token component comprises a smart card on which the token is stored and a card reader that is adapted to read the token stored on the smart card and supply the read token to the remote application manager component. However, Safadi discloses the token component comprises a smart card on which the token is stored and a card reader that is adapted to read the token stored on the smart card and supply the read token to the remote application manager component (secure processor, col 6, lines 42-60). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Safadi and Patel. The motivation would have been accessing pay-per-use services from multiple devices without requiring a new infrastructure.

***Response to Arguments***

38. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS

  
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